

AP 11/14



0212.66402

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wolfgang Hirschburger
Serial No.: 10/757,660
Conf. No.: 4465
Filed: 1/14/2004
For: NOSE TIP CONTROL FOR CORDLESS
HIGH SPEED ROTARY TOOL
Art Unit: 3722
Examiner: Gates, Eric Andrew

)
) I hereby certify that this paper is being deposited with
) the United States Postal Service as FIRST-CLASS mail
) in an envelope addressed to: Commissioner for Patents,
) P.O. Box 1450, Alexandria, VA 22313-1450, on this
) date.
) 10/6/2008
) Date
)
) Registration No. 26,174
) F-CLASS.WCM Attorney for Applicant(s)
) Appr. February 20, 1998
)
)
)

[Signature]

TRANSMITTAL OF APPEAL BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on January 31, 2008.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) was paid on March 28, 2008.

(complete (a) or (b) as applicable)

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

Extension fee for response within first month:
() By a small entity (1.9(f))..... \$ 65.00
() By other than a small entity \$ 130.00

Extension fee for response within second month:
() By a small entity (1.9(f))..... \$ 245.00
() By other than a small entity \$ 490.00

Extension fee for response within third month:
() By a small entity (1.9(f))..... \$ 555.00
() By other than a small entity \$ 1110.00

Extension fee for response within fourth month:

- () By a small entity (1.9(f))..... \$ 865.00
() By other than a small entity..... \$1730.00

() The extension fee has already been filed in this application.


() A check in the amount of \$ _____ for the extension of time fee is enclosed.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

() A check in the amount of \$ _____ is enclosed for filing the Appeal Brief.

(X) The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Deposit Account No. 07-2069. Should no proper payment be enclosed, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. (One additional copy of this Notice is enclosed herewith.)

Dated: October 6, 2008



Roger D. Greer
Registration No. 26,174

Address to which Correspondence is to be sent:

GREER, BURNS & CRAIN, LTD.
300 South Wacker Drive, 25th Floor
Chicago, Illinois 60606
(312) 360-0080



0212.66402

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wolfgang Hirschburger
Serial No.: 10/757,660
Conf. No.: 4465
Filed: 1/14/2004
For: NOSE TIP CONTROL FOR CORDLESS
HIGH SPEED ROTARY TOOL
Art Unit: 3722
Examiner: Gates, Eric Andrew

)
) I hereby certify that this paper is being deposited with
) the United States Postal Service as FIRST-CLASS mail
) in an envelope addressed to: Commissioner for Patents,
) P.O. Box 1450, Alexandria, VA 22313-1450, on this
) date.

) 10/6/2008
) Date

Registration No. 26,174

) F-CLASS.WCM Attorney for Applicant(s)
) Appr. February 20, 1998
)
)
)

TRANSMITTAL OF APPEAL BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on January 31, 2008.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) was paid on March 28, 2008.

(complete (a) or (b) as applicable)

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

Extension fee for response within first month:

() By a small entity (1.9(f))..... \$ 65.00
() By other than a small entity..... \$ 130.00

Extension fee for response within second month:

() By a small entity (1.9(f))..... \$ 245.00
() By other than a small entity..... \$ 490.00

Extension fee for response within third month:

() By a small entity (1.9(f))..... \$ 555.00
() By other than a small entity..... \$ 1110.00

Extension fee for response within fourth month:

- () By a small entity (1.9(f))..... \$ 865.00
() By other than a small entity \$1730.00

() The extension fee has already been filed in this application.


() A check in the amount of \$ _____ for the extension of time fee is enclosed.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

() A check in the amount of \$ _____ is enclosed for filing the Appeal Brief.

(X) The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Deposit Account No. 07-2069. Should no proper payment be enclosed, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. (One additional copy of this Notice is enclosed herewith.)

Dated: October 6, 2008



Roger D. Greer
Registration No. 26,174

Address to which Correspondence is to be sent:

GREER, BURNS & CRAIN, LTD.
300 South Wacker Drive, 25th Floor
Chicago, Illinois 60606
(312) 360-0080



0212.66402

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wolfgang Hirschburger

Serial No.: 10/757,660

Conf. No.: 4465

Filed: 1/14/2004

For: NOSE TIP CONTROL FOR
CORDLESS HIGH SPEED ROTARY
TOOL

Art Unit: 3722

Examiner: Gates, Eric Andrew

) I hereby certify that this paper is being deposited with
) the United States Postal Service as FIRST-CLASS mail
) in an envelope addressed to: Commissioner for Patents,
) P.O. Box 1450, Alexandria, VA 22313-1450, on this
) date.

) 10/6/08 *[Signature]*
) Date Registration No. 26174
) F-CLASS.WCM Attorney for Applicant(s)
) Appr. February 20, 1998
)
)
)
)
)
)
)

**APPELLANT'S BRIEF ON APPEAL
PURSUANT TO 37 CFR § 41.37**

This Appeal Brief is in support of Applicant's Notice of Appeal dated
August 5, 2008.

REAL PARTY IN INTEREST	1
RELATED APPEALS AND INTERFERENCES	2
STATUS OF CLAIMS	3
STATUS OF AMENDMENTS AFTER FINAL.....	4
SUMMARY OF CLAIMED SUBJECT MATTER.....	5
GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	7
ARGUMENT.....	8
Claims 1-5 are not anticipated under 35 U.S.C. 102(b) by Crutchfield.....	8
Claims 6-9 are not unpatentable under 35 U.S.C. 103(a) over Crutchfield in view of Von Hollen.....	13
Claim 11 is not unpatentable under 35 U.S.C. 103(a) over Crutchfield in view of Peot and further in view of Von Hollen.....	14
CONCLUSION	15
CLAIMS - APPENDIX	A-1
EVIDENCE - APPENDIX	A-4
RELATED PROCEEDINGS - APPENDIX	A-5

REAL PARTY IN INTEREST

Credo Technology Corporation.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims that are pending, finally rejected and appealed are 1-12.

STATUS OF AMENDMENTS AFTER FINAL

There have been no amendments after the last final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

The independent claims 1 and 10 are annotated with references to the specification and drawings, as follows:

1. A control mechanism (10; Fig. 1; Pg. 3/4-4/4) for a rotary hand tool having a generally cylindrical housing in which a drive motor is located, the housing having a generally tapered nose portion (12, Figs. 1, 2; Pg. 3/22-27) at an end from which a motor output shaft extends and a grip portion (12, Figs. 1, 2; Pg. 4/9-19) around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said control mechanism being a part of the tool and located substantially within the housing thereof and comprising:

an electrical control circuit (Fig. 5, Pg. 6/8-7/2) contained entirely within said housing, said circuit controlling the application of power to and the operation of the motor, including supplying current to the motor; and

a light touch switch (30, Figs. 4, 5; Pg. 5/3-6/8) having at least a first position and a second position coupled to said electrical control circuit for selectively enabling or disabling said control circuit to turn the motor on and off, wherein said motor current does not flow through said switch;

wherein said switch is disposed on the tapered nose portion of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.

10. Apparatus (10; Fig. 1; Pg. 3/4-4/4) for selectively controlling power applied to and the operation of the motor of a rotary hand tool having a generally cylindrical housing that includes a generally tapered nose portion (12, Figs. 1, 2; Pg. 3/22-27) that has a gradually reduced circumference toward an end from which an output shaft extends, and a grip portion (12, Figs. 1, 2; Pg. 4/9-19) around which an operator wraps a hand during operation of the tool, said apparatus comprising:

electrical control circuitry (Fig. 5, Pg. 6/8-7/2) for controlling power, including motor current that is applied to the motor, said electrical circuitry being a part of the tool and located entirely within the housing;

a switch (30, Figs. 4, 5; Pg. 5/3-6/8) having a switch button (34) and containing at least a pair of switch contacts that are selectively opened and closed responsive to actuation of said switch button, said switch being operatively connected to said control circuitry to control the operation of the motor, including the application of motor current to the motor, said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor, said switch being a part of the tool and located substantially within the tapered nose portion thereof; and

a cavity disposed in the tapered nose portion of the tool that is configured to receive at least a portion of said switch and permit actuation of said switch button (Pg. 11, claim 10, ln 5-6).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether the §102(b) rejection of claims 1-5, 10 and 12 based upon Crutchfield should be reversed.

Whether the §103(a) rejection of Claims 6-9 over Crutchfield in view of Von Hollen should be reversed.

Whether the §103(a) rejection of Claim 11 over Crutchfield in view of Peot and further in view of Von Hollen should be reversed.

ARGUMENT

Claims 1-5, 10 and 12 are not anticipated by Crutchfield under 35 U.S.C. 102(b).

The examiner has rejected claim 1 and others as being anticipated first by Markle, then Von Hollen and lastly by Crutchfield, even though Crutchfield was cited in the initial office action.

Claim 1 presently reads as follows:

1. A control mechanism for a rotary hand tool having a generally cylindrical housing in which a drive motor is located, the housing having a generally tapered nose portion at an end from which a motor output shaft extends and a grip portion around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said control mechanism being a part of the tool and located substantially within the housing thereof and comprising:

an electrical control circuit contained entirely within said housing, said circuit controlling the application of power to and the operation of the motor, including supplying current to the motor; and

a light touch switch having at least a first position and a second position coupled to said electrical control circuit for selectively enabling or disabling said control circuit to turn the motor on and off, **wherein said motor current does not flow through said switch;**

wherein said switch is disposed on the tapered nose portion of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool. (emphasis added)

Crutchfield fails to anticipate, teach or suggest this claim because it fails to include, *inter alia*, a light touch switch having at least a first position and a second position coupled to said electrical control circuit for selectively enabling or disabling said control circuit to turn the motor on and off **wherein the motor current does not flow through said switch.**

The examiner now contends in paragraph 4 that Crutchfield meets the claim language and particularly the language "wherein said motor current does not flow through said switch 30 (said switch 30 only including the

switch button device 30 and not the electrical elements of microswitch 78).” Not only has the examiner changed the switch to switch button device 30, rather than 28 in a previous rejection, the examiner has now **explicitly redefined the switch 30 as only including the switch button device 30 and not the electrical elements of microswitch 78.** This redefinition is an egregious mischaracterization of the Crutchfield switch and is contrary to the language of the specification itself.

Crutchfield’s specification introduces the **switch assembly 28** in the sentence “. . . when the DC motor 26 is activated by switch assembly 28 when placed in the ‘on’ position by depressing switch button device 30 down with respect to first opening 32 formed in the wall of front portion 14 and surrounding switch button device 30.” (Col. 3, lines 44-48) The switch assembly is further defined in the specification “. . . **switch assembly 28 comprises front mounting assembly 62, microswitch device 78, switch button device 30 and spring device 82.**” (Col 4, lines 45-49).

Crutchfield has always had only one actual switch device and that is the microswitch device 78. At paragraph 4, lines 55-58, in connection with Fig. 4b, it describes a “switch button device 30 comprises a ring-like portion 86 and a lever portion 88 which is cantilevered from said ring-like portion 86 at approximately 85°.” **The switch button device 30 is not a switch.** It is just a mechanical linkage. The actual switch of Crutchfield is the microswitch device 78 which necessarily has the switch contacts in it and **it is indisputable that the microswitch device 78 does have motor current flowing through it.** Therefore, Crutchfield fails to anticipate, teach or suggest claim 1.

There are also other relevant considerations with regard to the actual operation of Crutchfield that support applicants’ position. More particularly, the abstract states that a rectifier device is operatively connected to receive the AC voltage from the wall outlet and provide a DC output to the DC motor. A switch assembly is operatively connected between the output of the rectifier device and the DC motor. Moreover, at column 4, lines 27-45, the

specification describes the circuitry of Crutchfield and more particularly at lines 34-40 it states that “the 115-120 volt AC from the wall outlet is provided through electrical cord 20 to the rectifier means 76 which then provides the 115-120 volt DC for the DC motor. Microswitch device 78 which is slidably received in a predetermined portion of front mounted assembly 62 is operatively connected between the output of the rectifier means 76 and the DC motor 26.” Not only that, column 7, lines 40-42 states a switch assembly is operatively connected between said output from said rectifier means and an input to said 115-120 volt DC motor.

While there is no specific circuit diagram, there is no doubt or ambiguity from these recitations that the microswitch device 78 is connected in circuit between the motor and the rectifier and therefore the motor current necessarily flows through the switch which is totally opposite from the language of claim 1.

It is not surprising that Crutchfield would have his switch in circuit with the DC motor because it is a simple small electrical erasing machine for presumably erasing ink or pencil marks from writing materials such as paper or the like and there is very little load being applied to the eraser motor. For all of these reasons, it is believed that claim 1 should be allowed and such action is respectfully requested.

The dependent claims 2-5 necessarily incorporate the features of the claim 1 from which they depend in addition to defining other features and/or functionality and are therefore believed to be in condition for immediate allowance.

Claims 10 and 12 are also not anticipated by Crutchfield

Independent claim 10 is set forth below:

10. Apparatus for selectively controlling power applied to and the operation of the motor of a rotary hand tool having a generally cylindrical housing that includes a generally tapered nose portion that has a gradually reduced circumference toward an end from which an output shaft extends, and a grip portion around which an operator wraps a hand during operation of the tool, said apparatus comprising:

electrical control circuitry for controlling power, including motor current that is applied to the motor, said electrical circuitry being a part of the tool and located entirely within the housing;

a switch having a switch button and containing at least a pair of switch contacts that are selectively opened and closed responsive to actuation of said switch button, said switch being operatively connected to said control circuitry to control the operation of the motor, including the application of motor current to the motor, **said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor**, said switch being a part of the tool and located substantially within the tapered nose portion thereof; and

a cavity disposed in the tapered nose portion of the tool that is configured to receive at least a portion of said switch and permit actuation of said switch button. (emphasis added)

The arguments made above with regard to claim 1 also apply to claim 10. Additionally, in rejecting claim 10 as being anticipated by Crutchfield, the examiner ignores important language of the claim. More particularly, claim 10 specifically defines a switch in the claim as follows: “a switch having a switch button and containing at least a pair of switch contacts that are selectively opened and closed responsive to actuation of said switch button” and “said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor, said switch being a part of the tool and located substantially within the tapered nose portion thereof”.

The examiner’s responses to applicant’s arguments are contained in paragraph 18 on page 7 of the May 5, 2008 mail dated office action, where the examiner states:

Applicant's arguments that a switch button device of Crutchfield is not a switch as claimed in claims 1 and 10 is not persuasive. Webster's On-Line Dictionary describes a switch as "a device for making, breaking or changing the connections in an electric circuit". This definition in claim language does not require that the switch be part of the electrical linkage, and as such the mechanical switch 30 of Crutchfield meets the requirements of the claim. Applicant's arguments state that the switch button device 30 is just a mechanical linkage, but they do not state how the claim language does not allow for this interpretation which was based on the dictionary definition above.

This whole discussion is believed to be irrelevant for the reason that applicant has specifically claimed the **switch as having a switch button and a pair of switch contacts**. That being the case, Webster's On-Line Dictionary's definition of a switch simply is not relevant. If in fact the examiner's switch is only the switch button 30, then the examiner's switch has no switch contacts which is a physical impossibility. Certainly, a switch button 30 without switch contacts fails to meet the language of the claim. It is believed that the examiner's position is illogical and fatally flawed. It is respectfully requested that the rejection of claims 1 and 10 be reversed.

The dependent claim 12 necessarily incorporate the subject matter of the independent claim 10 from which it depends and in addition add other features and/or functionality that are not found in the independent claim and for this reason dependent claim 12 is also believed to be in condition for immediate allowance.

**Claims 6-9 are not unpatentable under 35 U.S.C. 103(a)
over Crutchfield in view of Von Hollen**

The examiner has cited Von Hollen as teaching the use of a layer of rubber surrounding the portion of the nose portion in which a switch 55-49 is disposed, and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen. However, these claims are clearly dependent upon claim 1 and necessarily incorporates the subject matter of it.

Since Von Hollen does not supply the basic deficiency of Crutchfield because Crutchfield does not distinctly disclose **wherein said motor current does not flow through said switch** as required in claim 1, it is believed that these dependent claims are in condition for immediate allowance.

**Claim 11 is not unpatentable under 35 U.S.C. 103(a) over
Crutchfield in view of Peot and further in view of Von Hollen.**

The examiner has cited Von Hollen as teaching the use of a layer of rubber surrounding the portion of the nose portion in which a switch 55-49 is disposed, and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen. However, this claim is clearly dependent upon claim 10 and necessarily incorporates the subject matter of it.

Since Von Hollen does not supply the basic deficiency of Crutchfield and Peot because neither do not distinctly disclose said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor as required in claim 10, it is believed that claim 12 is in condition for immediate allowance.


CONCLUSION

The dependent claims necessarily incorporate the features of the claims from which they depend in addition to defining other features and/or functionality and are therefore believed to be in condition for immediate allowance. If the rejections of claims 1 and 10 are reversed, the pending dependent claims should also be allowed.

For the above reasons, applicant requests the Board to reverse the outstanding rejections. The case should then be permitted to pass to issue.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By 
Roger D. Greer
Registration No. 26,174

October 6, 2008

300 South Wacker Drive, Suite 2500
Chicago, Illinois 60606
(312) 360-0080
Customer No. 24978

CLAIMS - APPENDIX

1. A control mechanism for a rotary hand tool having a generally cylindrical housing in which a drive motor is located, the housing having a generally tapered nose portion at an end from which a motor output shaft extends and a grip portion around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said control mechanism being a part of the tool and located substantially within the housing thereof and comprising:

an electrical control circuit contained entirely within said housing, said circuit controlling the application of power to and the operation of the motor, including supplying current to the motor; and

a light touch switch having at least a first position and a second position coupled to said electrical control circuit for selectively enabling or disabling said control circuit to turn the motor on and off, wherein said motor current does not flow through said switch;

wherein said switch is disposed on the tapered nose portion of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.

2. The control mechanism of claim 1 wherein said switch is configured to be generally rectangular.

3. The control mechanism of claim 1 wherein said switch has a predetermined thickness.

4. The control mechanism of claim 1 wherein said first position disables said electrical control circuit and said second position enables

said electrical control circuit.

5. The control mechanism of claim 1 wherein the tapered nose portion on which said switch is disposed generally corresponds to a location of the operator's index finger when grasping the tool.

6. The control mechanism of claim 1 further comprising a layer of flexible grip material surrounding at least a portion of the nose portion.

7. The control mechanism of claim 1 further comprising a layer of grip material surrounding the portion of the nose portion in which said switch is disposed.

8. The control mechanism of claim 6 further comprising a layer of rubber surrounding the portion of the nose portion in which said switch is disposed.

9. The control mechanism of claim 6 wherein said flexible grip material abuts said switch when said compressible material is compressed.

10. Apparatus for selectively controlling power applied to and the operation of the motor of a rotary hand tool having a generally cylindrical housing that includes a generally tapered nose portion that has a gradually reduced circumference toward an end from which an output shaft extends, and a grip portion around which an operator wraps a hand during operation of the tool, said apparatus comprising:

electrical control circuitry for controlling power, including motor current that is applied to the motor, said electrical circuitry being a part of the tool and located entirely within the housing;

a switch having a switch button and containing at least a pair of switch contacts that are selectively opened and closed responsive to actuation of said switch button, said switch being operatively connected to said control circuitry to control the operation of the motor, including the application of motor current to the motor, said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor, said switch being a part of the tool and located substantially within the tapered nose portion thereof; and

a cavity disposed in the tapered nose portion of the tool that is configured to receive at least a portion of said switch and permit actuation of said switch button.

11. Apparatus as defined in claim 10 further comprising a layer of grip material surrounding at least a portion of the grip portion in which said switch is located.

12. Apparatus as defined in claim 10 wherein the outer surface of said switch button is generally coextensive with the outer surface of said nose portion.

EVIDENCE - APPENDIX

None.

RELATED PROCEEDINGS- APPENDIX

None.